

3624\$
PATENT

Attorney Docket No. 26548.0007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Clark et al.

Application Serial No.: 09/845,669

Filed: April 30, 2001

For: Maximization of a Hedged Investment Budget for an
Index-Linked Insurance Product

Group Art Unit: 3624

Examiner: Patel, Jagdish

Special Program Examiner for Group 3624
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION TO MAKE SPECIAL

Sir:

The Applicants hereby petition to make this application special pursuant to the Advancement of Examination procedures set forth 37 C.F.R. § 1.102(d) and MPEP 708.02 on the grounds that a search of the prior art has been made.

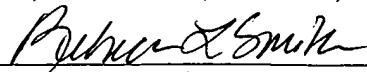
12/14/2005 MAHME1 00000003 09845669

01 FC:1464

130.00 OP

Certificate of Transmission

I hereby certify that this correspondence is being transmitted via first class mail to Special Program Examiner for Group 3624, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 8, 2005.



Rebecca Smith

In re Application of: Clark et al.
Application Serial No.: 09/845,669
Filed: April 30, 2001
Attorney's Docket No. 26548.0007
Page 2

REMARKS

In accordance with MPEP 708.02, Part VIII, subparagraphs (A) through (E), the Applicants state as follows:

(A) **Petition Fee.** A check in the amount of \$130.00 is enclosed for the Petition Fee as set forth in 37 C.F.R. §§ 1.102(d) and 1.17(h). Any additional fee or credit associated with this Petition may be charged to our Deposit Account No. 19-5029.

(B) **All Claims Directed to Single Invention.** The Applicants are confident that all the claims in the pending application are directed to a single invention. The claims, as filed, do not define independent and distinct inventions; therefore, no restriction should be required.

Nevertheless, if the Patent Office determines that the claims are not directed to a single invention, then the Applicants will make an election without traverse as a prerequisite to the grant of special status for the pending application. The Applicants prefer, however, to defer any required election until the Patent Office determines that a restriction is required, and then to make any such election using the established telephone restriction practice, as permitted in MPEP 708.02, Part VIII (B).

(C) **Search Made.** The Applicants have conducted a pre-examination search using the services of Terry W. Kramer, Esq. of Kramer & Associates. A copy of Mr. Kramer's letter is attached to this Petition as Exhibit 1, and incorporated herein by reference.

In re Application of: Clark et al.
Application Serial No.: 09/845,669
Filed: April 30, 2001
Attorney's Docket No. 26548.0007
Page 3

Mr. Kramer's letter sets forth the search field, including the classes and subclasses (U.S. and foreign), and the examiners consulted during the search. The letter also includes a schedule of references found.

(D) Submission of References. The Applicants filed concurrently herewith an Information Disclosure Statement disclosing the references located during the search with filing dates prior to the filing of the present application. U.S. Patent Publication No. 2005/0154617, to Ruggieri et al. (*Ruggieri*), and U.S. Patent Publication No. 2002/0147670 to Lange (*"Lange II"*) have split priority dates, where parts of the content contained in each predates the filing date of the present application. Both the *Ruggieri* and *Lange II* patent publications are considered in their entirety as prior art to the present application for the purposes of this petition only. Such an assumption is not to be considered an admission that the contents contained in the *Ruggieri* and *Lange II* patent publications, in their entirety, are prior art to the present application. The remaining references listed in the pre-examination search referenced in Mr. Kramer's letter are not considered prior art to the present application.

A copy of the IDS Form PTO-1449 is attached hereto as Exhibit 2. The IDS includes the prior art references listed below except for U.S. Patent No. 6,343,272 to *Payne* et al., which was included in an earlier filed IDS dated May 29, 2002.

In re Application of: Clark et al.
 Application Serial No.: 09/845,669
 Filed: April 30, 2001
 Attorney's Docket No. 26548.0007
 Page 4

Patent/Publication Number	Inventor's Name	Issue Date/ (Publication Date)	Title
5,704,045	King et al.	December 30, 1997	System and Method of Risk Transfer and Risk Diversification Including Means to Assure with Assurance of Timely Payment and Segregation of the Interests of Capital
6,321,212	Lange	November 20, 2001	Financial Products Having a Demand-Based, Adjustable Return, and Trading Exchange Therefor
6,360,210	Wallman	March 19, 2002	Method and System for Enabling Smaller Investors to Manage Risk in a Self-Managed Portfolio of Assets/Liabilities
6,636,834	Schirripa	October 21, 2003	Computer System and Methods for Management, and Control of Annuities and Distribution of Annuity Payments
2002/0138388	Reiss	(September 26, 2002)	Method and System for Reconciling Equity Hedge Funds
2002/0147670	Lange	(October 10, 2002)	Digital Options Having Demand-Based, Adjustable Returns, and Trading Exchange Therefor
2005/0154617	Ruggieri et al.	(July 14, 2005)	System and Method for Providing Global Information on Risks and Related Hedging Strategies

The following are the prior references deemed by the Applicants to be most closely related to the subject matter encompassed by the claims of the pending application.

In re Application of: Clark et al.
Application Serial No.: 09/845,669
Filed: April 30, 2001
Attorney's Docket No. 26548.0007
Page 5

Patent/Publication Number	Inventor's Name	Issue Date (Publication Date)	Title
6,343,272	Payne et al.	January 29, 2002	System for Analyzing and Managing Equity Participation Life Insurance and Annuity Contracts
2004/0030625	Rabson et al.	(February 12, 2004)	Managing a Life Insurance Investment

(E) Detailed Discussion of the References and Patentable Subject Matter.

The following is a discussion summarizing each reference uncovered in the search and analyzing the patentability of the claimed invention over the references.

The vast majority of the patents that were uncovered in the patent search generally fall into two categories. The first category includes business methods and/or devices that are essentially directed to tools and the use of tools for assisting in making investment decisions, assessing risk, and modeling investment activity, referred to below as the "Assessment Patents." For example, U.S. Patent No. 6,360,210 discloses a computer-implemented system that is intended to reduce market risk for a specified portfolio, by examining the expected portfolio risk, pricing the expected risk, and transferring the expected risk or related market risk in exchange for consideration, which can be in the form of cash, other property, or future returns, such as an assignment of various portions or parts of the portfolio or the potential increase in value of the portfolio.

As discussed in more detail below, none of these references teach or suggest, among other

things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application.

The second category includes business methods and/or devices that are essentially directed to strategies of managing investment instruments such as life insurance, annuities, etc., referred to below as the "Investment Management Patents." For example, U.S. Patent 6,343,272 discloses a system for analyzing and managing a plurality of specified life insurance policies and annuity contracts on behalf of an insurance carrier.

However, while these patents may seek to address similar issues as the present application, they do so in a completely different way. As discussed in more detail below, all of these patents also lack the steps of "determining a hedged investment budget based at least in part on the projected annual fixed income yield and an estimated cost of the annual guarantee over the term" and "upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee" of the present invention.

In re Application of: Clark et al.
Application Serial No.: 09/845,669
Filed: April 30, 2001
Attorney's Docket No. 26548.0007
Page 7

Risk Assessment Patents:

U.S. Patent 6,360,210 to Wallman:

The *Wallman* patent is directed to a computer-implemented system intended for reducing market risk in a specified portfolio, by examining the expected portfolio risk, pricing the expected risk, and transferring the expected risk or related market risk in exchange for consideration, which can be in the form of cash, other property, or future returns, such as an assignment of various portions or parts of the portfolio or the potential increase in value of the portfolio.

However, the *Wallman* patent does not teach or suggest a method for implementing an index-linked life insurance product. Moreover, the *Wallman* patent does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *Wallman* patent.

U.S. Patent Application No. 2002/0138388 to Reiss:

The *Reiss* patent is directed to a method and system intended for tracking compliance requirements imposed on a portfolio account containing a plurality of assets distributed among one or more investment fund categories, containing one or more investment vehicles. The method identifies a liability balance associated with each investment vehicle within each of the fund categories, identifies an asset balance associated with the account and divests a portion of the particular investment vehicle when the asset balance is in violation of a known relation with regard to the liability balance. The method also provides an indication when the asset balance is within a known relation to the liability balance.

Although the system and method described in the *Reiss* patent involves the monitoring of investments in equity markets, the disclosed compliance tracking system and method does not teach or suggest the implementing of an index-linked life insurance product having a term and an annual guarantee as described in the claims of the Applicants' invention. Specifically, the system and method described in *Reiss* does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent

In re Application of: Clark et al.
Application Serial No.: 09/845,669
Filed: April 30, 2001
Attorney's Docket No. 26548.0007
Page 9

claims of the present application. Therefore, the present invention is patentable over the *Reiss* patent.

U.S. Patent Application No. 2005/0154617 to Ruggieri et al.:

The *Ruggieri* patent is directed to a system and method intended for information and data aggregation and analysis which is intended to provide risk managers, benefits managers, brokers, insurers and other insurance professional access to information resources, knowledge management tools, and analytical models intended to increase their value and productivity.

However, the *Ruggieri* patent does not teach or suggest a method for implementing an index-linked life insurance product. Moreover, the *Ruggieri* patent does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *Ruggieri* patent.

Investment Management Patents:

U.S. Patent No. 5,704,045 to King et al.:

The *King* patent is directed to a method intended to utilizing a data processing system and other means to establish a system of statutorily segregated reserve accounts through which compensation received for accepting risk is matched with equity or debt sourced from specific investors, being sufficient to pay a total loss on the maximum risk liability accepted, intended to result in an improved capital structure for an enterprise which adopts the system. The system relies on the expertise of third party specialists using the data processing system to agree the acceptance of risk. As each risk is accepted, a contract is issued defining specific terms and transactional capital (under the care of independent custodians and sufficient to pay the maximum limit on the contract) is allocated through use of the data processing system to a statutory reserve account to support the agreement being issued.

The system described in the *King* patent is intended to protect the individual interests of each risk diversification participant from being impacted by the activities of any other participant through a method of segregating the interests of all participants in the system by a means of statutory reserve accounts created by the data processing system or otherwise. It is also intended to provide the assurance of timely payment and permits profits and losses of specific risks to be allocated to specific equity or debt providers.

However, the *King* patent does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or
AO 1406529.3

investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *King* patent.

U.S. Patent 6,321,212 to Lange (“Lange I”):

The *Lange I* patent is directed to methods and systems intended for trading and investing in groups of demand-based adjustable-return contingent claims, and for establishing markets and exchanges for such claims. A method of *Lange I* patent includes the steps of establishing a plurality of defined states and a plurality of predetermined termination criteria, wherein each of the defined states corresponds to at least one possible outcome of an event of economic significance; accepting investments of value units by a plurality of traders in the defined states, and allocating a payout to each investment upon the fulfillment of predetermined termination criteria.

Although the *Lange I* patent involves payout at the occurrence of predetermined termination events, the *Lange I* patent does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed

income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *Lange I* patent.

U.S. Patent 6,343,272 to Payne et al.:

The *Payne* patent is directed to a system intended for analyzing and managing a plurality of specified life insurance policies and annuity contracts on behalf of an insurance carrier. The life insurance policies or annuity contracts depend on stock market performance in that the account value increase is determined as a percentage of the performance of a stock market index, with set caps and floors. The percentage is adjusted according to the yield on fixed rate assets. The system is intended to manage the increased risk from participation in the stock market by periodically monitoring assets and liabilities and determining the purchase and sale of stock options and other hedging instruments to cover the risks.

The *Payne* patent is similar to the present application in that both involve investing a portion of assets in fixed rate investments and a portion in hedge investments and having guaranteed cumulative returns. However, the *Payne* patent does not teach or suggest, among

other things, (1) determining a hedged investment budget based at least in part on the projected

AO 1406529.3

annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *Payne* patent.

U.S. Patent 6,636,834 to Schirripa:

The *Schirripa* patent is directed to an annuity system intended to allow transfers to or from a fixed annuity without discontinuity in the payment distribution to the annuitant. The annuity system allows for the initial payment of the variable annuity to be the same as the fixed annuity payments. This is accomplished by setting the initial payment of the variable annuity at the time of transfer or purchase equal to the fixed annuity payment and deriving the subsequent payments based on market interest rates at the time each payment is made. Each subsequent payment is based on a current pricing interest rate rather than a fixed assumed investment rate (AIR). The pricing interest rate may vary at each payment interval and may be tied to an objective market interest rate or indicator such as a treasury rate, a corporate bond rate, or other objective rate.

Compensation for the change in actuarial present value of the annuity as a result of a change in interest rates between payments is provided by an interest adjustment factor in the

AO 1406529.3

payment progression function. The annuity system may be implemented to provide payments that are part fixed and part variable. The investor may transfer some or all of his or her annuity funds from fixed annuities to variable annuities, from variable annuities to fixed annuities or from variable annuities to variable annuities. Payments from the transferor fund are reduced in proportion to the amount transferred, whereas the payments from the transferee fund are increased in proportion to the amount transferred.

Although the *Schirripa* patent involves the transfer of funds from a fixed annuity to a variable annuity, the *Schirripa* patent does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *Schirripa* patent.

U.S. Patent Application No. 2002/0147670 to Lange ("Lange II"):

The *Lange II* patent is directed to a method, system and plan intended for using life insurance products to achieve an increase in donor life insurance gifts to universities and colleges and optimized excess returns on university and college endowment investment funds by creating

AO 1406529.3

irrevocable trusts for selected donors, appointing a trustee of the life insurance trust obtaining investment capital from the respective nonprofit endowment investment fund; underwriting universal, variable universal, whole, term or other life insurance policies on the selected donor; selecting the optimal policy to be underwritten from a variety of issuing insurers based upon the planned premium, guaranteed premium, length of guarantee, interest crediting rate, lapse rate subsidies, and other variables relevant to the overall economic performance of the policy in terms of the expected internal rate of return on the future death benefit; using the capital obtained from the endowment investment funds to finance the initial premium payments and subsequent premiums, where necessary, on the selected donor policies; splitting the insurance policy death benefits between the university or college and the endowment investment fund by naming both as beneficiaries of the irrevocable life insurance trust; and optimizing the returns to the endowment investment funds versus the life insurance donations received by the university or colleges by allocating various percentages of the death benefit to be paid to the endowments investment funds or the university or college.

However, the *Lange II* patent does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount

AO 1406529.3

credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *Lange II* patent.

U.S. Patent Application No. 2004/0030625 to Rabson et al.:

The *Rabson* patent is directed to a method of managing a life insurance investment, selecting at least one predefined index and linking a basic sum assured to the selected index to define a total sum assured, so that the value of the total sum assured increases or decreases with changes in the value of the selected index or indices. In the *Rabson* patent the policyholder selects a basic sum assured. This is the nominal value of the policyholder's investment, which will be payable on the policyholder's death. A basic premium payable periodically by the policyholder, typically a monthly premium, is calculated according to the sum assured.

However, instead of investing the actual premiums incrementally, a single investment, equivalent to investing the actual sum assured, is made using derivative instruments. The cost of purchasing these instruments is much less than the amount of the sum assured. In other words, the policyholder's investment has a value equal to the sum assured from inception, and the periodic premiums payable by the policyholder will reflect the costs associated with purchasing the investment. When the investment is linked to various indices, the actual value of the investment (or sum assured) varies with the performance of the indices.

Although the systems and methods described in the *Rabson* patent involve investing life insurance by linking monies to a predefined index, the *Rabson* patent does not teach or suggest

AO 1406529.3

the implementing of an index-linked life insurance product having a term and an annual guarantee as described in the claims of the present application. Specifically, the system and method described in the *Rabson* patent does not teach or suggest, among other things, (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application. Therefore, the present invention is patentable over the *Rabson* patent.

CONCLUSION

In summary, none of the references teach or suggest the claimed invention. Specifically, none of these references teach or suggest, alone or in combination, a method for implementing an index-linked life insurance product having a term and an annual guarantee, which includes the steps of (1) determining a hedged investment budget based at least in part on the projected annual fixed income yield (or investment budget) and an estimated cost of the annual guarantee over a term; or (2) upon the occurrence of a predetermined event, if the amount credited based on the index-linked earnings is not equal to at least the annual guarantee (or guarantee value) compounded over the term, using funds from one or more reserves or a risk fund to increase the amount credited to be substantially equal to the compounded annual guarantee (or guarantee value), as claimed by the independent claims of the present application.

Having satisfied the requirements for the Advancement of Examination as set forth in 37 C.F.R. § 1.102(d) and MPEP 708.02, the Applicants hereby seek accelerated examination of this patent application. The Commissioner is authorized to charge any fee, or credit any refund, to our Deposit Account No. 19-5029.

Respectfully submitted,



Malvern U. Griffin III
Attorney for Applicants
Registration No. 38,899

Date: December 8, 2005

SUTHERLAND ASBILL & BRENNAN, LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309-3996
(404) 853-8407
(404) 853-8806 (fax)